

### **REMARKS**

Applicant respectfully requests reconsideration and allowance of the subject application in view of the amendments and the remarks to follow. Claim 12 is amended. Claims 1-34 are pending in this application.

To clarify the record, Applicant respectfully notes that claims 29-34 do not stand rejected in the present action. No grounds for rejection are mentioned anywhere in the Office Action. The Examiner should provide a revised Office Action that is complete as to all pending matters, including the previously- and presently-pending claims.

The amendment to claim 12 addresses a minor informality noted during review. However, this amendment is not intended to alter the scope of the claims.

**35 U.S.C. § 101**

Claims 10-12 and 25-27 are stated in the Office Action (p. 2) to stand rejected under 35 U.S.C. §101. Applicant respectfully traverses and requests reconsideration.

The present Office Action states (pp. 2, 3) that these claims are not directed to statutory subject matter and/or fall within the "printed matter" exception to 35 U.S.C. §101. The previous Office Action dated Sept. 26, 2003, had rejected claims 10-12 and 25-28 on grounds that (p. 2) these claims were apparently then directed to non-functional descriptive data stored on a medium.

In both cases, simply stating an unsupported conclusion and ignoring the recitations in Applicant's claims that relate to useful, concrete and tangible results does not comprise an appropriate basis for rejection, as is described below in more detail.

In the instant Action, the claims are mischaracterized as being directed to "a data structure, per se ..." and that such "cannot be considered a "manufacture" since a data structure is not produced from raw materials and has no tangible, physical form or structure." However, claims 10 and 25 et seq. clearly recite "One or more computer media ....", which is produced from raw materials and has tangible physical form and structure. Further, "per se" means (Merriam-Webster's Collegiate Dictionary, Tenth Ed., copyright 1996, Merriam-Webster, Inc., Springfield MA, p. 630, copy enclosed) "by, of, or in itself ...." The claims do not recite a data structure by itself.

Further, Applicant notes that the Court of Appeals for the Federal Circuit has stated, in *In re Lowry* (32 USPQ2d, 1031), that "Board of Patent Appeals and

Interferences erred, in upholding rejection of claims for data processing system under 102(e) and 103, by analogizing data structure and computer memory of claimed system to printed matter, since board improperly extended printed matter rejection to field of information stored in memory, and since prior cases involving printed matter have no factual relevance if invention requires that information be processed by computer rather than human mind." (headnote 1, emphasis added). In this opinion, the Court states (p. 1033) that "The examiner rejected claims 1 through 5 under 35 U.S.C. §101 as non-statutory subject matter." and that "the burden of establishing the absence of a novel, nonobvious functional relationship rests with the PTO". Simply ignoring such fails to meet this burden.

The nature of judge-made law (e.g., appellate court decisions) differs substantially from much of scientific or mathematical reasoning and is such that later opinions may overturn or reverse earlier opinions in response to evolution of civilization and technology. Accordingly, reliance on dated opinions inapposite to present facts and circumstances and not in accordance with presently-applicable legal precedent does not comport with appropriate legal reasoning.

Additionally, the Office Action relies (p. 3) on the predecessor to 35 U.S.C. §101 as well as a dated CCPA opinion (*In re Russel*, 9 USPQ 181, 182, (CCPA 1931)), thus applying legal principles predating the modern computer. As such, this reasoning is improper and inappropriate to the claimed subject matter of the present application.

As well, Applicant further notes that the Examiner has not responded adequately or in full to the legal arguments presented in the Response dated January 26, 2004 (explicitly enumerating eleven separate legal arguments) or

those of the Response dated July 1, 2003. Applicant notes the requirements of MPEP §707.07(f), entitled "Answer All Material Traversed". This MPEP section states that "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."

Applicant has previously provided **eleven** distinct legal arguments showing that such rejection is improper. Of these, at least ten are applicable to the present rejection and have not been responded to by the Examiner, viz., (i) that 35 U.S.C. §101 clearly contemplates such subject matter, and, as such Applicant is entitled to apply for a patent encompassing such claims; (ii) that the interpretation of such statute that is provided at MPEP §706.03 requires a full development of reasons for a rejection, which is not present on the record; (iii) the rejection fails to provide legal authority in support of the conclusions stated in the Office Action, and thus fails to meet the burden set forth in the above-noted MPEP provision; (iv) the rejection fails to comport with the guidelines set forth in MPEP §706.03(a); (v) the rejection fails to comport with the guidelines set forth in MPEP 2106, which explicitly states that "'Computer-related inventions' include inventions implemented in a computer and inventions employing computer-readable media"; (vi) 35 U.S.C. §112 requires the Applicant to present claims in the manner which it regards as its invention, and that 35 U.S.C. §103(a) states that the subject matter of the claimed invention is to be considered "as a whole"; (vii) MPEP §2111.01, subsection II(A), sets forth guidelines requiring, inter alia, that "Office personnel have the burden to establish a prima facie case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or

does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101.", at odds with the relationships noted within the claims and summarized at p. 20 of the prior Response; (viii) Applicant is entitled to employ functional description in describing claimed subject matter, as is discussed in the MPEP at §2173.05(g); (ix) that claim 21, contained in the de Vries reference, which the Examiner continues to rely on in making the art rejections, does not appear to comport with the standard for finding statutory subject matter now being promulgated by the Examiner and (x) that the Examiner has not responded adequately or in full to legal arguments presented in Applicant's Response dated July 1, 2003, thus failing to comply with the provisions of MPEP §707.07(f).

The Examiner has failed to provide any indication on the record that the Examiner even read the arguments put forth by the Applicant. Applicant has provided the Examiner with a revised Amendment with each argument specifically and separately enumerated in order to assist the Examiner in locating and identifying each argument and thus to facilitate meeting the obligations to respond to each such argument set forth clearly in the MPEP. Thus, for at least these fourteen enumerated reasons, Applicant respectfully submits that claims 10-12 and 25-27 comply with 35 U.S.C. §101. Accordingly, Applicant respectfully requests that the §101 rejections be withdrawn.

**35 U.S.C. § 103**

Claims 1-12, 20, 22, 23 and 25-28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over "Synchronized Multimedia Integration Language (SMIL) 1.0 Specification", W3C Recommendation 15 June 1998, (hereinafter "W3C") in view of U.S. Patent No. 6,332,144 to deVries et al. (hereinafter "deVries").

To clarify the record, Applicant respectfully notes that claims 29-34 do not stand rejected in the present action. No grounds for rejection are mentioned anywhere in the Office Action. The Examiner should provide a revised Office Action that is complete as to all pending matters, including the previously- and presently-pending claims.

In traversing the rejections, it is helpful to first review the teachings of the references. Accordingly, brief summaries of W3C, deVries, Logan and Wei appear below.

W3C provides a specification for a "Synchronized Multimedia Integration Language" (Title). This language is intended to allow integration of "a set of independent multimedia objects into a synchronized multimedia presentation. Using SMIL, an author can

1. describe the temporal behavior of the presentation
2. describe the layout of the presentation on a screen
3. associate hyperlinks with media objects" (Abstract).

deVries describes a "Technique For Annotating Media" (Title), and teaches that "To annotate media, one or more particular times within a period defined by a start time and an end time of a media stream forming an item of audio or video

media, are identified. The identified times are those at which content within the media stream corresponds to an annotation value. The annotation value is associated with the identified times to annotate the media." (Abstract).

Logan is directed to an "Audio Message Exchange System" (Title). Logan teaches "An audio program and message distribution system in which a host system organizes and transmits program segments to client subscriber locations. The host organizes the program segments by subject matter and creates scheduled programming in accordance with preferences associated with each subscriber. Program segments are associated with descriptive subject matter segments, and the subject matter segments may be used to generate both text and audio cataloging presentations to enable the user to more easily identify and select desirable programming. A playback unit at the subscriber location reproduces the program segments received from the host and includes mechanisms for interactively navigating among the program segments. A usage log is compiled to record the subscriber's use of the provided program materials, to return data to the host for billing, to adaptively modify the subscriber's preferences based on actual usage, and to send subscriber-generated comments and requests to the host for processing. Voice input and control mechanisms included in the player allow the user to perform hands-free navigation of the program materials and to dictate comments and messages which are returned to the host for retransmission to other subscribers." (Abstract).

Wei teaches "A Distributed Media Authoring System For Networked Scholarly Workspaces" (Title). Wei teaches that this provides "a software framework for composing distributed media in the context of university research

and instruction. Authors may compose networked media, software tools and mediastreams, and can freely annotate media by media of any form using schema of their own design. Faculty and student authors compose distributed media using common Macintosh, World Wide Web and NeXTSTEP applications, supported by services from UNIX workstations." (Abstract).

The Office Action states (p. 5) that "W3C discloses a system (p.26, ex. 4) for associating annotations, contained in the <text.../> tag, to the plurality of media streams, representing different versions of multimedia content ... as explained in the header of the example." The Office Action also states (p. 10) that "Applicant argues that the text tag does not qualify as annotations. The Office disagrees. The text is contained with a <par> tag (§ 4.2.1), with the <switch> block."

The Office Action further states (id.) that "The ellipses at 6, 9, and 12, are clearly meant to be the alternative parts. These are the different versions of multimedia content." Applicant disagrees and requests reconsideration.

In this example, <text .../> represents the multimedia content and is not an annotation (see, e.g., the Title of this section - "Choosing between content written for different screens"). Note that no other element is provided that could represent any other media content in this example. Note also that in the immediately preceding example, "<audio .../>" is the syntax, with "..." representing a specific audio source, such as: src="joe-audio-french" system-language ="fr". Ellipsis simply indicates that the argument pointing to the text source is arbitrary in this example.

The Office Action also states (p. 5) that "W3C does however disclose that both the annotations and media are referenced by a URI (p. 19, "src")...." The



Office Action also states (p. 5) that W3C teaches "a data field representing an annotation ...." Applicant respectfully disagrees. W3C is silent with respect to annotations, and the Examiner has repeatedly admitted this on the record (p. 3, Office Action dated September 26, 2003; see also p. 7, Office Action dated June 18, 2003).

W3C provides fixed, predetermined fields corresponding to a specific source or data type having no relationship to critical commentary regarding content. Such is not an annotation as described in Applicant's specification or as the term is used in the English language.

Applicant notes the requirements of MPEP §2111.01, entitled "Plain Meaning", previously presented hereinabove (see supra). The interpretation relied on by the Examiner clearly gives the term "annotation" a meaning repugnant to the ordinary meaning of the term.

A dictionary definition of "annotation" has been previously provided to attempt to clarify such, taken from p. 47 of Merriam-Webster's Collegiate Dictionary, Tenth Ed. (copyright 1996, Merriam-Webster, Inc., Springfield MA). This definition is: "n 1: a note added by way of comment or explanation 2: the act of annotating". This dictionary defines "annotate" to mean "vi: to make or furnish critical or explanatory notes or comment ~ vt : to make or furnish annotations for (as a literary work or subject)". In other words, "ANNOTATE" implies furnishing critical, historical or explanatory notes.

Applicant's specification provides examples of annotation at least at p. 2, - line 19 et seq. (additional discussion and examples of annotation are provided in the detailed description), stating that:

Multimedia presentations may also include “annotations” relating to the multimedia presentation. An annotation is data (e.g., audio, text, video, etc.) that corresponds to a multimedia presentation. Annotations can be added by anyone with appropriate access rights to the annotation system (e.g., the lecturer/trainer or any of the students/trainees). These annotations typically correspond to a particular temporal location in the multimedia presentation and can provide a replacement for much of the “in-person” interaction and “classroom discussion” that is lost when the presentation is not made “in-person” or “live”. As part of an annotation, a student can comment on a particular point, to which another student (or lecturer, assistant, etc.) can respond in a subsequent annotation. This process can continue, allowing a “classroom discussion” to occur via these annotations. Additionally, some systems allow a user to select a particular one of these annotations and begin playback of the presentation starting at approximately the point in the presentation to which the annotation corresponds.

W3C states (p. 17, §4.2.3, entitled "Media Object Elements") that "ref, animation, audio, img, video text and textstream" are media object elements. W3C further indicates that such media object elements may have attributes such as duration. Such is completely inconsistent with the characterization of such objects as annotations provided in the Office Action. This and previous Office Actions fail to identify any teaching whatsoever of annotation anywhere in W3C. As such, W3C provides no disclosure, teaching, suggestion or motivation for any "annotation".

The Office Action further states (p. 5) that "W3C does however disclose that both the annotations and media are referenced by a URI (p. 19, "src") ...." Such is in error for several reasons.

First, as noted above, W3C is silent with respect to any annotation.

Second, combining the teachings of W3C with those of deVries fails to provide "an annotation database, coupled to the multimedia server, that stores a plurality of annotations, wherein each of the plurality of annotations is correlated

with different versions of multimedia content contained in the plurality of media streams", as recited in claim 1, any "storage device to store a data structure; and an annotation module to store an annotation in the storage device so that the annotation is correlated with different versions of the same multimedia content via the data structure", as recited in claim 7, any "second data field identifies a plurality of different versions of the multimedia content to which the annotation corresponds", as recited in claim 10, any "method comprising: receiving an indication of a version of media content being presented to a user; identifying a collection of annotations corresponding to the media content, each annotation corresponding to a plurality of different versions of the media content; and providing selected annotations from the collection of annotations to the client computer for presentation to the user", as recited in claim 20, any "second data field, correlated through the data structure to the first data field, configured to cause a processor to correlate the second data field with a plurality of different versions of the multimedia content to which the annotation corresponds", as recited in claim 25 or any "receive a user request to create a new annotation; and correlate the new annotation with different versions of the same multimedia content via the data structure, wherein the different versions of the same multimedia content is part of a plurality of media streams", as recited in claim 28.

In contrast, deVries teaches (col. 2, lines 10-13) that "According to the present invention, an item of audio or video media is annotated by identifying the particular time or times within the period defined by the start and end times of a media stream forming an item of media." There is no teaching, disclosure,

suggestion or motivation in either W3C or deVries of any annotation being associated with multiple versions of multimedia content.

Accordingly, combining the teachings of the references does not provide the invention as recited in any of independent claims 1, 7, 10, 20, 25 or 28 or any claims dependent therefrom. Additionally, there is no teaching or disclosure within the references to guide one of ordinary skill in selecting elements from the references or combining the selected elements.

Claim 13 recites "A method comprising: receiving a user request to create a new annotation; and associating the new annotation with a set of media streams, wherein the set of media streams is part of a plurality of media streams, and wherein each of the plurality of media streams is a different version of multimedia content", which is not taught, disclosed, suggested or motivated by the cited references.

As noted above, W3C is silent with respect to annotations. The word "annotation" does not appear anywhere in W3C. Modifying the teachings of W3C fails to provide the invention as recited in claim 13 and specifically fails to provide "associating the new annotation with a set of media streams", as recited in claim 13. Logan addresses audio message exchange and does not teach multimedia streams or different versions of such. As a result, the proposed combination fails to provide the subject matter recited in claim 13.

None of the references provides any teaching, disclosure, suggestion or motivation that would lead one to any "computer-readable memory containing a computer program that is executable by a computer to perform the method of claim 13", as recited in claim 19, and the Office Action fails to provide any clue as

to where related subject matter might be found. The argument (p. 8) that **"Regarding dependent claim 19**, the computer readable media for executing the methods of claims 13 [sic] are rejected under the same rationale" (a similar argument is presented with respect to the subject matter of claim 23 at page 7) appears to reflect the earlier-provided "it would have been obvious" argument. Such fails to establish any correspondence between the teachings of the references and the recitations of the claim. Clarification, and a meaningful legal analysis, are **again** respectfully requested.

Claim 29 recites "A system comprising: a multimedia server having access to a plurality of media streams that represent different versions of multimedia content, the multimedia server being configured to provide at least one of the plurality of media streams to a respective requester; an annotation database, coupled to the multimedia server, that stores a plurality of annotations supplied by one or more past or present users of the plurality of media streams, wherein each of the plurality of annotations is correlated with different versions of multimedia content contained in the plurality of media streams; and an annotation server, coupled to the annotation database, to manage storage and retrieval of the plurality of annotations in response input data from the one or more past or present users", which is not taught, disclosed, suggested or motivated by the references of record. Further, the Examiner has completely and improperly ignored the recitation of claim 29 and claims dependent therefrom, and merely notes (p. 2) that claim 29 is an independent claim. Such is not meaningful grounds for rejection. Clarification and a meaningful basis for rejection are respectfully requested.

All of the unpatentability rejections fail to meet the standards set forth in the MPEP for establishing a prima facie case of unpatentability. These are set forth in MPEP §2142, entitled "Legal Concept of Prima Facie Obviousness" (see also MPEP §706.02(j)).

This MPEP section states that "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." The references fail to teach or disclose the elements recited in the claims. Accordingly, the references cannot provide motivation to modify their teachings to arrive at the invention as claimed, and the Examiner has identified no such teaching or disclosure in the references. As a result, the first prong of the test cannot be met.

MPEP §2143 further states that "Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Inasmuch as the references fail to provide all of the features recited in Applicant's claims, as noted with particularity hereinabove, the third prong of the test is not met. As a result, there cannot be a reasonable expectation of success. As such, the second prong of the test cannot be met.

MPEP §2143 additionally states that "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20

USPQ2d 1438 (Fed. Cir. 1991)." This fourth criterion cannot be met because the references fail to teach or disclose the elements recited in the claim.

Accordingly, the unpatentability rejections fail all of the criteria for establishing a prima facie case of obviousness as set forth in the MPEP.

Inasmuch as there is no guidance within the references, and as there is no basis for the Examiner's contentions within the cited references, the only possible motivation for these contentions is hindsight reconstruction wherein the Examiner is utilizing Applicant's own disclosure to construct a reason for combining the cited references. The Examiner is reminded that hindsight reconstruction is not an appropriate basis for a §103 rejection. (*See, e.g., Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990) (explaining that hindsight reconstruction is an improper basis for rejection of a claim).).

The impropriety of "obvious to try" as a standard for unpatentability is described in more detail below with reference to MPEP §2145(X)(B). This MPEP section states that:

The admonition that 'obvious to try' is not the standard under §103 has been directed mainly at two kinds of error. In some cases, what would have been 'obvious to try' would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.... In others, what was 'obvious to try' was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it. *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) (citations omitted).

No indication as to which parameters are critical and no direction as to which of many possible choices is likely to be successful has been identified in the references relied upon.

Further, Applicant notes that no evidence has been provided as to why it would be obvious to combine or modify the teachings of these references. Evidence of a suggestion to combine or modify may flow from the prior art references themselves, from the knowledge of one skilled in the art, or from the nature of the problem to be solved. However, this range of sources does not diminish the requirement for actual evidence. Further, the showing must be clear and particular. See *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999).

To recapitulate the several legal arguments relative to alleged unpatentability: (i) the Office Action mischaracterizes the record; (ii) the references do not provide the elements recited in the claims; (iii) the Office Action (a) mischaracterizes the teachings of the references, (b) improperly gives the terminology of the claims and/or references meaning repugnant to the ordinary meaning of the terms and (c) improperly gives this terminology meaning inapposite to the disclosure of the application; (iv) the rejections fail to meet the criteria for a prima facie showing of unpatentability set forth in the MPEP; (v) the rejections are based on impermissible hindsight; (vi) the rejections employ an improper "obvious to try" standard; and (vii) no proper evidence of suggestion to modify or combine has been provided.

Dependent claims 2-6, 8, 9, 11, 12, 14-19, 21-24, 26-27 and 30-34 are allowable as depending from an allowable base claim and for their own recited features which are neither shown nor suggested by the prior art. For at least these



reasons, Applicant respectfully requests that the §103 rejections of claims 1-34 be withdrawn, and that claims 1-34 be allowed.

### **Deficiencies in Examination**

The Examiner's response to argument is deficient in multiple regards. A first deficiency is that the response to argument clearly fails to respond to Applicant's arguments with respect to the rejections under 35 U.S.C. §101 and §103, or, in the alternative, is an admission that these rejections are defective.

Applicant notes the requirements of MPEP §707.07, entitled "Completeness and Clarity of Examiner's Action". This MPEP section cites 37 CFR §1.104, entitled "Nature of examination" which in turn states, in subsection (b), entitled "Completeness of examiner's action" that "The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made."

This MPEP section further states, in subsection (f) thereof, entitled "Answer All Material Traversed", that "Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment. Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." and also states, under a heading labeled "Examiner Note" that "The examiner must address all arguments which have not already been responded to in the statement of the rejection." Such is hardly taken out of context as alleged (p. 12) in the Office Action and hardly corresponds to "a different portion of the MPEP". The Office Action clearly fails to comport with these requirements as set forth in the MPEP, at least because the Office Action both fails to address Applicant's arguments with respect to statutory

subject matter and continues to reject claims as being directed to non-statutory subject matter. Applicant has enumerated the various grounds of argument in this Response in order to facilitate meaningful rebuttal.

A second deficiency is that the combinations used in the unpatentability rejections fail to provide all of the features recited in any of Applicant's independent claims. The Examiner has ignored these features without providing any appropriate legal basis for doing so.

A third deficiency is the failure to respond to all arguments traversing the unpatentability rejections. Merely repeating that "it would be obvious" to provide the features recited in the claims does not constitute a basis for rejection of the claims, particularly when the references fail to provide the features recited in the claims and the rejections fail to meet the standards for such rejections as set forth in the MPEP and as demonstrated by Applicant.

A fourth deficiency is to combine the teachings of disparate references absent any guidance in the references to support the combination when main intentions of each of the cited references are defeated by the combination and the Examiner has completely failed to respond to Applicant's repeated legal arguments showing this to be the case.

A fifth deficiency is a complete failure to provide **any** grounds for rejection of claim 29 and claims dependent therefrom.

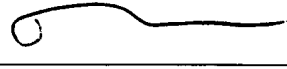
For at least these reasons, the Office Action fails to comport with appropriate standards for examination. The Examiner should either allow Applicant's claims or provide a meaningful basis for rejection and an appropriate response to Applicant's arguments.

**Conclusion**

Claims 1-34 are in condition for allowance. Applicant respectfully requests reconsideration and issuance of the subject application. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

Respectfully Submitted,

Date: July 12, 2004

By:   
Frederick M. Fliegel  
Reg. No. 36,138  
(509) 324-9256 x239